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Paper 87
Filed 24 March 2010

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

RAYMOND J. ROUSSY
Junior Party
(Application No. 11/067,225)

v.

HOWARD E. JOHNSON, Jr.
Senior Party
(Patent Nos. 6,955,219, 7,093,657 and 7,270,182).

Patent Interference Nos. 105,707 and 105,708 (SCM)
(Technology Center 3600)

Before MEDLEY, Administrative Patent Judge.

Decision – Motions – Bd.R. 125(a)

A. Introduction

On 11 March 2010, the parties filed a Joint Substantive Motion to Correct Inventorship (Paper 73). For the reasons that follow, the Joint Substantive Motion to Correct Inventorship is GRANTED.

B. Findings of Fact

1. Roussy is involved in both Interference 105,707 and Interference 105,708 on the basis of application 11/067,225, filed 28 February 2005.
2. Johnson is involved, for Interference 105,707, on the basis of (1) patent 6,955,219, granted 18 October 2005, based on application 10/613,511, filed 03 July 2003; and (2) patent 7,093,657, issued 22 August 2006, based on application 11/247,997, filed 10 October 2005.
3. Johnson is involved, for Interference 105,708, on the basis of (1) patent 6,955,219, issued 18 October 2005, based on application 10/613,511, filed 03 July 2003; (2) patent 7,093,657, issued 22 August 2006, based on application 11/247,997, filed 10 October 2005; and (3) patent 7,270,182, issued 18 September 2007, based on application 11/506,395, filed 18 August 2006.
4. Interferences 105,707 and 105,708 were consolidated. (Paper 3).
5. Johnson real party in interest is Enlink Geoenergy Services, Inc. (Paper 7).
6. Roussy real party in interest is the inventor Raymond J. Roussy. (Paper 13).
7. On 11 March 2010, the parties filed a Joint Substantive Motion to Correct Inventorship. (Paper 73).
8. The Joint Substantive Motion to Correct Inventorship seeks to add Raymond J. Roussy to the involved Johnson Patents.
9. The Joint Substantive Motion includes petitions to correct the inventorship of the involved Johnson patents and the appropriate petition fees (Papers 78, 81, 84).

10. The Joint Substantive Motion submissions include a statement made by Raymond J. Roussy and Howard E. Johnson each averring that the error in inventorship occurred without deceptive intent (Ex. 1010, 3:18-19).
11. The Joint Substantive Motion submissions further include a statement made by Howard E. Johnson in which he agrees to the change of inventorship to add Raymond J. Roussy. (Ex. 1012, 2:8-9).
12. The Joint Substantive Motion submissions also include a statement made by Raymond E. List, authorized to act on behalf of Enlink Geoenergy Services Inc., in which he agrees to the change of inventorship to add Raymond J. Roussy (Ex. 1011, 2:18-19).

C. Analysis

Roussy and Johnson jointly move to correct the inventorship of the involved Johnson patents 6,955,219, 7,093,657 and 7,270,182 by adding Raymond J. Roussy as an inventor.

The Director is authorized to correct the inventorship of patents when all the inventors and assignees request correction and the inventorship was incorrect due to an error made without any deceptive intent. Section 256 of 35 USC is as follows:

Whenever through error a person is named in an issued patent as the inventor, or through error an inventor is not named in an issued patent and such error arose without any deceptive intention on his part, the Director may, on application of all the parties and assignees, with proof of the facts and such other requirements as may be imposed, issue a certificate correcting such error.

The regulation that implements the above statutory provision is 37 CFR § 1.324 which provides that:

- (a) Whenever through error a person is named in an issued patent as

the inventor, or through error an inventor is not named in an issued patent and such error arose without any deceptive intention on his or her part, the Director, pursuant to 35 U.S.C. 256, may, on application of all the parties and assignees, or on order of a court before which such matter is called in question, issue a certificate naming only the actual inventor or inventors. A petition to correct inventorship of a patent involved in an interference must comply with the requirements of this section and must be accompanied by a motion under § 41.121(a)(2) or § 41.121(a)(3) of this title.

- (b) Any request to correct inventorship of a patent pursuant to paragraph (a) of this section must be accompanied by:
- (1) Where one or more persons are being added, a statement from each person who is being added as an inventor that the inventorship error occurred without any deceptive intention on his or her part;
 - (2) A statement from the current named inventors who have not submitted a statement under paragraph (b)(1) of this section either agreeing to the change of inventorship or stating that they have no disagreement in regard to the requested change;
 - (3) A statement from all assignees of the parties submitting a statement under paragraphs (b)(1) and (b)(2) of this section agreeing to the change of inventorship in the patent, which statement must comply with the requirements of § 3.73(b) of this chapter; and
 - (4) The fee set forth in § 1.20(b).

The Director has delegated the authority to decide petitions to change inventorship of a patent involved in an interference to the Board. Manual of Patent Examining Procedure (MPEP), Eight Edition, Rev. 7 (July 2008), § 1002.02(g)(4).

The Joint Substantive Motion to Correct Inventorship sufficiently demonstrates that the parties are entitled to the requested relief. The parties have submitted a statement by Raymond J. Roussy, the inventor sought to be added, who testifies that the inventorship error occurred without deceptive intent. (Ex.

1010, 3:18-19). The parties have also submitted a statement by Howard E. Johnson, the named inventor of the involved Johnson patents, who testifies that he agrees to the proposed change of inventorship and that the inventorship error occurred without deceptive intent. (Ex. 1012, 2:8-9). Raymond E. List, a representative of Johnson's real party in interest, Enlink Geoenergy Services Inc., consents to the change of inventorship. (Ex. 1011, 2:18-19). The Petitions to Correct Inventorship of the involved Johnson Patents include authorization to charge the appropriate petition fees. (Papers 78, 81, 84).

The Joint Substantive Motion is GRANTED.

Roussy has filed a request to abandon its involved application. (Paper 74). The abandonment is construed as a request for adverse judgment. Judgment is entered in a separate concurring paper. Since Roussy has abandoned its involved application and the interference is terminated, Johnson Substantive Motion 1 (Paper 53), Roussy Substantive Motion 1 (Paper 46) and Roussy Substantive Motion 2 (Paper 50) are DISMISSED as moot.

D. Order

It is

ORDERED that the Joint Substantive Motion to Correct Inventorship and accompanying Petitions to Correct Inventorship are GRANTED;

FURTHER ORDERED that the inventorship of Patents 6,955,219, 7,093,657 and 7,270,182 be changed as reflected on the corresponding Certificates of Correction;

FURTHER ORDERED that this Decision, the Petitions to Correct Inventorship, the Requests for Certificate of Correction, and the Certificates of Corrections for Johnson Patents 6,955,219, 7,093,657 and 7,270,182 be entered

into the corresponding administrative records of Patents 6,955,219, 7,093,657 and 7,270,182;

FURTHER ORDERED that this Decision and the Certificates of Correction for Johnson Patents 6,955,219, 7,093,657 and 7,270,182 be forwarded to the Certificate of Corrections Branch for entry of the corresponding Certificates of Correction; and

FURTHER ORDERED that Johnson Substantive Motion 1, Roussy Substantive Motion 1 and Roussy Substantive Motion 2 are DISMISSED.

cc (via electronic filing):

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